



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,934	08/07/2002	Axel Muntermann	(H)02MUN0018USP	9216

7590 04/29/2005  
M Robert Kestenbaum  
11011 Bermuda Dunes NE  
Albuquerque, NM 87111

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT PAPER NUMBER

3739

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 10/049,934	<b>Applicant(s)</b> MUNTERMANN, AXEL	
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 6-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-25 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-9,26 and 28-31 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 7, 2005 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Specification***

The disclosure is objected to because of the following informalities: page 1, paragraph 1 of the specification continues to make reference to the appended claims which is improper in US Patent practice.

Appropriate correction is required.

***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the originally filed drawings are deemed informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Objections***

Claim 30 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 30 depends from claim 1 and recites the same structural limitation, therefore failing to further limit claim 1.

***Claim Rejections - 35 USC § 102***

Claims 1, 2, 4, 6-9 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham et al ('671).

Cunningham et al discloses an electrode with a rounded tip. As asserted previously, it is impossible to determine what constitutes a "reduced number of electrical interference centers". The Cunningham et al electrode will inherently have a "reduced" number of such centers compared to at least other electrode known in the art. It is noted that the wherein clause added by amendment to claim 1 is directed to a product by process, and weight is not given to the process of making the product (see MPEP 2113). Further, the Cunningham et al electrode is subjected to various electrolytes (e.g. saline and blood) and is made from platinum. It is noted that the Cunningham et al electrode (20) has a rounded surface structure (20b – see Figure 3). The diameter of the electrode is 2 mm, hence the radius of curvature of the rounded surface structure (20b) is 1 mm which is greater than the radius of curvature set forth in amended claim 1 and new claims 30 and 31.

***Claim Rejections - 35 USC § 103***

Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al ('671) in view of the teaching of Eggers et al ('700).

Cunningham et al provide an electrode which presents a "reduced number of electrical interference centers" as set forth in claim 1. Further, Cunningham et al teach of providing the electrode in an electrolyte solution such as blood and/or saline fluid. However, Cunningham et al fail to specifically disclose a second electrode (e.g. return electrode) which is in contact with the solution.

Eggers et al disclose an analogous catheter device, and specifically teach that it is generally well-known in the art to provide such an electrosurgical ablation catheter with a return electrode on the catheter in proximity to the treatment electrode and in contact with a solution containing ions (i.e. saline or blood). An electric voltage is applied to the electrodes.

While it is noted that applicant's intent is to claim a much different device/process than is taught by the prior art, the claims, as presently written, are sufficiently broad so as to be anticipated and obviated by the prior art as applied.

To have provided the Cunningham et al catheter as a bipolar catheter system having both active and return electrodes on the catheter body for the treatment of tissue would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Eggers et al.

***Allowable Subject Matter***

Claims 10-25 are allowed.

Art Unit: 3739

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to the pending claims have been fully considered and are not deemed persuasive.

With regards to claim 1, the examiner maintains that the Cunningham et al electrode includes a "rounded surface structure" (i.e. tip) that has a radius of curvature much larger than the radius of curvature stated in the rejected claims. The applicant has acknowledged that the diameter of the Cunningham et al electrode is 2mm (page 7 of the response). Therefore the tip portion has a radius of curvature of 1mm which is much greater than the 500nm or 10nm radius of curvature set forth in the claims. The claims do not identify what specific structure on the electrode has the recited radius of curvature.

Applicant has made no amendment to claim 26. Applicant states at page 8 of the response that "Neither in Cunningham or Eggers can a method for surface treatment of the electrode be found." Applicant further contends on that page that "an electrode is not described where the ablation or mapping electrode has a rounded surface structure whose edges have a radius of curvature of more than approximately 500nm, or more than 100nm, or more than 10nm." It is the examiner's position that claim 26 does not recite a method for surface treatment of an electrode, nor does claim 26 recite the

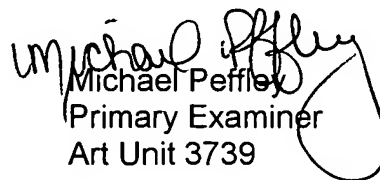
Art Unit: 3739

particular radius of curvature of the edge of the electrode. As such, these arguments are deemed not persuasive, and the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
April 26, 2005